

# Browne Woods & George LLP

## MEMORANDUM

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### STATE BAR OF CALIFORNIA INTELLECTUAL PROPERTY SECTION TRADE SECRET COMMITTEE

#### *May 24, 2005 Meeting Minutes*

The Trade Secrets Committee held a telephonic meeting on May 24, 2005. The following are the minutes of that meeting:

1. **Attendance.** The following Committee members attended the meeting: Ben Scheibe, Joanna Mendoza, Bec Edelsen, Randy Kay, Scott Plamandon, David Morales, and Brian Walton.

2. **Update On Trade Secrets Treatise.** Randy updated Committee members on the progress of the trade secret treatise that was edited by and written by members of the Committee. It is anticipated that the treatise will be published shortly and promoted by the State Bar through, among other means, announcements on the State Bar website and in *New Matter*, and being featured at State Bar programs such as the annual convention in September and the IP Institute in November.

3. **Upcoming programs.** The members discussed recent and upcoming programs, which included:

- a. **April 27-28, 2005** – Bec, Ben, Joanna, and Randy spoke on two different panels at the Intellectual Property Litigation Issues for In-House Counsel program, held on April 27 and 28, 200 in San Jose. Bec, Joanna, and Randy spoke on Trade Secrets and Competitive Position and Ben participated in a panel discussing Trial Issues in IP Litigation Panel. It is anticipated that the In-House Counsel program will become an annual event and the Committee will strive to participate each year.
  - b. **May 19, 2005 lunch program to be rescheduled:** The lunch program developed by Bec and entitled “*Protecting Your Business From Departing Employees*” that had been rescheduled for May 19, 2005, will be rescheduled to a date to occur during the summer. The timing of the program will be coordinated with the publication of the treatise.
  - c. **September 9 2005:** The Committee will present a program at the State Bar convention in San Diego on September 9 at 4:45 p.m.
  - d. **November 2005:** The Committee is presenting a program for the IP Institute to be held November 4-5, 2005 at the Napa Valley Marriott Hotel and Spa: The program will be on November 4 at 2:45 p.m. and will be a panel discussion on as-yet undetermined topics related to trade secrets. Ben is organizing the program.
4. **Speaking Opportunities/Writing Opportunities.** The Committee members discussed the need for the Committee to keep a flow of articles to *New Matter*. John Yates and Ben Scheibe have articles in progress. Members interested in writing an article (from 1500 to 6000 words) should e-mail Ben or the editors of *New Matter* (with a

copy to Ben) with a proposed topic and target date so as to reserve the topic with *New Matter*. The articles need not be in depth, law review type articles, and can cover narrow topics that may be of interest to members of the IP Section. Members are encouraged to take briefs or research memoranda from their practice and turn these into articles if the topics are of interest to the trade secret or IP community.

**5. Plain English Trade Secret Jury Instruction Project.** As mentioned in prior minutes, a subcommittee has been established, consisting of Ben Scheibe, Carolyn Sieve, Randy Kay, Marshall Lerner, Bec Edelson, and Robert Freitas. Robert Freitas has volunteered to head the Committee and to act as a clearinghouse to collect instructions from Committee members. Although Robert has received a few instructions, he has asked for additional instructions from Committee members. All Committee members are encouraged to provide trade secret instructions they have found useful in the past to Robert Freitas: [RFreitas@Orrick.com](mailto:RFreitas@Orrick.com)

**6. New Project(s).**

- a. Website:** The “Frequently Asked Questions” page on our Committee’s website is somewhat out of date. Committee members are asked to review the page with an eye towards updating the pages and making them more user friendly. Vice Chair David Morales is heading up this project. Although David has heard from one or two volunteers, additional volunteers would be helpful. Volunteers should e-mail David ([dmorales@lgpatlaw.com](mailto:dmorales@lgpatlaw.com)) and suggestions for website improvements can be e-mailed to David as well or submitted at the next meeting. Our current pages may be viewed at:

[http://www.calbar.ca.gov/state/calbar/calbar\\_sections\\_generic.jsp?sImagePath=Intellectual-Property-Section\\_with-right-menu.gif&sCategoryPath=/Home/Attorney%20Resources/Sections/Intellectual%20Property%20Law/Standing%20Committees/Trade%20Secrets&sAdsPath=sectionsads/IP\\_Cmte\\_Secrets\\_Home.html&sFileType=HTML&sRightMenuPath=sectionsrightmenu/IP\\_Cmte\\_Home-Page.html&sCatHtmlPath=html/IP\\_Cmte\\_Secrets\\_Home.html](http://www.calbar.ca.gov/state/calbar/calbar_sections_generic.jsp?sImagePath=Intellectual-Property-Section_with-right-menu.gif&sCategoryPath=/Home/Attorney%20Resources/Sections/Intellectual%20Property%20Law/Standing%20Committees/Trade%20Secrets&sAdsPath=sectionsads/IP_Cmte_Secrets_Home.html&sFileType=HTML&sRightMenuPath=sectionsrightmenu/IP_Cmte_Home-Page.html&sCatHtmlPath=html/IP_Cmte_Secrets_Home.html)

- b. **CLE By Phone:** There is nothing new to report. David Shaub is working on a potential program and Ben will seek additional information from David before the next meeting.
- c. **Legislative Reform:** Joanna Mendoza has circulated a comprehensive proposal identifying various issues relating to the California UTSA and proposing changes thereto. The proposal will be sent to all Committee members and a telephonic call arranged to discuss its contents and the next step towards proceeding.
- d. **Amicus Brief or Letter:** Joanna reported on the previously discussed idea of having the Committee or Section send a letter to the Supreme Court in connection with a pending petition for review pertaining to proper application of CCP § 2019(d). The position to be asserted by the Section or Committee would be that additional guidance from the Courts is needed with respect to the proper application and use of Section 2019(d). The idea has been circulated among members of the IP Section's Amicus Committee but to date has not generated substantial interest. Joanna will

circulate the pending Petition for Review to additional members of the Committee to see if there is sufficient interest to push this matter to the fore.

**7. Next Meeting.** The Trade Secret Committee will have its next telephonic meeting on July 12, 2005 at 3:00 p.m. Ben will circulate call-in information and an agenda in advance of the meeting.